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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No. 399

NATIONAL PRESSURE COOKER COMPANY,
a corporation,
Petitioner,

vs.

ALUMINUM GOODS MANUFACTURING COMPANY,
a corporation,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

CHARLES L. BYRON,
HOWARD W. HODGKINS,
GERRIT P. GROEN,
First National Bank Bldg.,
Chicago 3, Illinois.
Counsel for Respondent.

Scheffer Printing Company, Del. 7171

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PETITION SETS FORTH NO ADEQUATE REASON FOR GRANTING WRIT.

"This is an ordinary patent case." This sentence is the opening sentence of the decision of this court in the case of *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.,* 261 U. S. 387, 388. The decision goes on to state the conditions upon which this court should grant a writ of certiorari. This is on page 393 where the court states:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases

involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

his court further emphasized these two conditions in its cision in *Magnum Import Co., Inc.* v. *Coty*, 262 U. S. 9, 163, where it also stated:

"The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

In the instant case, neither of the two requisite conditions to the granting of petitions for writs of certiorari present. The decision which petitioner seeks to have viewed is not in conflict with any decision of any other ircuit Court of Appeals, and no question of public importance is involved.

Nor does the petition present "special and important easons," as required by Rule 38 (5) of the rules of this ourt.

This is an ordinary patent suit and the only question nvolved is as to the validity of claims 1, 2 and 6 of the Vittenberg Letters Patent No. 2,218,188. The following statement of this court in *Keller* v. *Adams-Campbell o.*, 264 U. S. 314, 317, therefore is controlling:

"Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile the decisions of circuit courts of appeal on the same patent."

Reasons Relied Upon by Petitioner Insufficient To Entitle It to a Writ of Certiorari.

The several reasons upon which the petition is based will be considered briefly in the order in which they appear in the petition.

I.

The first of the three reasons relied on by petitioner for the allowance of the writ is based on an allegation that the Circuit Court of Appeals erred in finding that no "new result was produced." This position appears to be merely a quibble over the meaning of the words "new result." The Circuit Court of Appeals agreed in its opinion with the findings of fact of the District Court that "the patent in suit possessed a greater utility than any of its predecessors, it was safer, simpler and easier to operate, cost less to manufacture and required less expense for repairs and servicing." Consequently, as to these findings of fact, the Circuit Court of Appeals agreed with the District Court. It disagreed, however, with the District Court in that court's finding that a "new result" was produced. The Court of Appeals stated that there was nothing in the record to show that the Wittenberg pressure cooker performed any differently as a pressure cooker in its operation upon the food therein than did any of the prior art pressure cookers. This statement of the Circuit Court of Appeals is clearly supported by the record and is correct. It does not conflict with any applicable decisions of this court.

The petitioner cites, in support of its argument, the old and well-known case decided by this court in 1881, *Loom Co* v. *Higgins,* 105 U. S. 580. In that case a loom was held

patentable on the basis that it achieved a "new result" by producing fifty yards a day when prior looms had never produced more than forty yards a day. It is not apparent how that decision has any application to the present case. There is no showing whatever in this case that the Wittenberg pressure cooker cooked any more food in a given period of time or cooked it more efficiently than prior art cookers. It did not produce fifty pounds of food where other cookers had never produced more than forty, nor did it produce food which was better cooked.

The petitioner also refers to the decision of this court in *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, and alleges that a decision there used the words "improved result" and "new result" as synonymous. In that case, again, the subject matter of the patent was a machine for producing a product. The court held that it did produce the product more efficiently and, on that basis, affirmed the concurrent holdings of the District Court and Circuit Court of Appeals.

It is important to point out that there are no concurrent decisions in the present case. While the Circuit Court of Appeals did not disturb the findings of fact of the District Court, it did draw a definite and opposite conclusion from those facts. It, therefore, reversed the decision of the District Court.

The statement in the opinion of the Circuit Court of Appeals as to no "new result" is, however, in no way controlling as to the conclusion which the court reaches. The court definitely found (R. 372) that the structure of the Wittenberg patent was anticipated by the prior art and invalid thereover. Consequently, the exact meaning which the court intended to confer upon the words "new result" is a moot question in this instance.

II.

The second reason relied on by the petitioner for the allowance of the petition for writ of certiorari is based on an argument that the Circuit Court of Appeals has not followed the provisions of Rule 52(a) of the Rules of Civil Procedure. A portion of this rule quoted by petitioner in its brief is as follows:

> "* * * Findings of fact shall not be set aside unless clearly erroneous, *and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses* * * *."

This quotation from the rule is correct, but due regard must be given to that portion of that quotation which has been emphasized in italics above. In the present case, there is no question whatever of the credibility of any witness. The court's decision does not turn on testimony of witnesses, but on the consideration of the legal effect of the prior art. This prior art includes both that cited by the Patent Office during the prosecution of the Wittenberg patent and other earlier references introduced before the court by the defendant.

The petitioner's position appears to be, in brief, that, first, the question of validity is a question of fact and, second, that the appellate court cannot reverse a finding of validity as a fact if there is any evidence whatever to support such a finding. While the question as to whether validity is properly a finding of fact or a conclusion of law is apparently somewhat confused in the published decisions, it is obvious that a holding of validity is subject to review by an appellate tribunal and subject to reversal. It is unnecessary to cite the large number of cases in which Circuit Courts of Appeals have reviewed decisions of District Courts and reversed findings of such courts as

to validity. It is equally true that this court, in a substantial number of its decisions in patent cases, has reversed findings of lower tribunals holding patents valid, and has held them invalid. It certainly cannot be argued that in all such cases there was no basis whatever for the finding of the lower tribunal or tribunals.

To go back to the question as to whether validity is properly a finding of fact or a conclusion of law, it is desired to point out that the decisions cited by the petitioner on pages 9 and 10 of its brief as supporting the finding of fact theory do not, in fact, support that theory. The first decision referred to is that in *Dooley* v. *Pease,* 180 U. S. 126. That is not a patent case. It was a case based on the ownership of personal property. It held that the findings of fact by the trial court were conclusive in courts of review. This related to actual facts and not to opinions or conclusions drawn from the facts. The court held that the facts stated in the findings were evidentiary only, but they were sufficient to support the finding of the ultimate fact.

The second case cited, that of *Lavender* v. *Kurn,* 327 U. S. 645, also was not a patent case. It related to a claim for damages of a brakeman who might have been accidentally killed in a railroad yard. This case was tried by a jury, and the jury had a chance to observe the witnesses and decide as to their credibility. That is directly contrary to the present situation where there was no jury and no question of credibility of witnesses. In the decision, the court stated, pages 652-53, as follows:

> "* * * Under these circumstances it would be an undue invasion of the jury's historic function for an appellate court to weigh the conflicting evidence, judge the credibility of witnesses and arrive at a conclusion opposite from the one reached by the jury."

The next decision is that of *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364. This was a patent case. The validity of certain claims of a patent on heel-lasting machines was sustained. The court, on page 365, stated:

> "• • • In pressing us to grant the writ, the petitioner insisted that it desired no retrial of the facts but merely a proper application of the law to the facts found by the courts below. We granted the writ."

In the present case that is exactly the action taken by the Circuit Court of Appeals for the Seventh Circuit. They properly applied the law to the facts as found by the court below. In the cited case there were concurrent findings of the District Court and the Circuit Court of Appeals that there were new combinations which produced an improved result. In this decision, this court held the finding of an improved result "was a finding of fact." Nevertheless, it did not merely affirm on the basis that there was supporting evidence. It reviewed the case to determine whether the factual "improved result" constituted patentable invention.

The next decision cited in Petitioner's Brief is that of *United States* v. *Esnault-Pelterie,* 299 U. S. 201. This was a decision of this court reviewing a decision in a patent case by the Court of Claims. It shows the position of this court as to the matter of validity being a conclusion of law rather than a finding of fact. On that point, the decision is directly contrary to the purpose for which it was apparently cited by the petitioner. The decision stated, on page 202:

> "• • • The record does not show whether at first the conclusion of law contained any statement as to validity or infringement."

Further, on page 203, it quotes further conclusions of law of the Court of Claims as follows:

> "* * * Upon the foregoing special findings of fact, which are made a part of the judgment herein, the court decides as a conclusion of law that the plaintiff's patent is valid and has been infringed by the United States and that he is entitled to compensation therefor under the act of June 25, 1910."

On page 206 there is a further pertinent statement. There this court stated:

> "* * * The failure of the lower court to make specific findings upon the main issues does not lay upon this court the duty of examining, analyzing and comparing the circumstantial facts found to ascertain whether as a matter of law they establish validity and infringement."

This same case was again before this court, and is reported in *United States* v. *Esnault-Pelterie,* 303 U. S. 26. There this court, by way of dicta, made the following statement:

> "* * * We are not unmindful of the rule that where, with all the evidence before the court, it appears that *no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structure and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art,* or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law." (p. 30, authorities cited)

While the above quoted statement was merely *dicta* so far as the case in which it appears is concerned, yet it affords a very reasonable reconciliation between decisions which have held that validity and infringement are questions of fact and those which have held them to be

questions of law. If the question of invention is determined by merely a comparison of the undisputed structures of the prior patents with that of the patent in suit, without requiring expert testimony and without presenting any disputed questions of fact, it would seem reasonable that a question of law is presented, and likewise the question of infringement is merely one of law, if it requires, as in the instant case, only a comparison of the plaintiff's patent with the accused device, as to the construction and operation of which there is no dispute.

At this point, on page 10 the petitioner's brief uses one of its numerous quotations of the words "we think" from the decision of the Circuit Court of Appeals. This use of those words, as well as their repeated use later in the brief, is absolutely misleading. The Circuit Court of Appeals for the Seventh Circuit definitely did not base its decision in this case on merely a "we think." What that court stated on page 9 of its decision (R. 372) is:

> "* * * It could be that the Examiner was wrong when he disallowed the claims and right when he allowed them. However, our study of the prior art in connection with the comments of the Examiner thereon leads us to the conclusion that his action in disallowing the claims was proper. And we are very definitely of the view that the patentability of these combination claims was not aided by the amendments responsible for their allowance."

This makes it very clear that the Circuit Court of Appeals carefully studied the prior art and were "very definitely" of the opinion that the claims were invalid.

On page 11 of petitioner's brief, the decision of the Circuit Court of Appeals for the Second Circuit in *Arnstein* v. *Porter,* 154 Fed. (2d) 464, is quoted. This, as stated, was a copyright case. The quotation in petition-

er's brief sets forth that the court believes its function is "to review" the "legal conclusions" in the decision of the District Court. It goes on to state that it is not a function of the Court of Appeals to determine whether it would have made the findings of fact, but merely whether they rest on sufficient evidence in the record. The decision has no apparent bearing upon the situation in the present case. There the appellate court reversed a decision of the District Court which dismissed the action on defendant's motion for summary judgment and returned the case for trial before a jury. The statements quoted by petitioner in its brief are mere dicta and were not pertinent to the decision of that case, nor do they have any bearing upon the decision of the present case.

The next case referred to on page 11 of petitioner's brief is that in *Lincoln Stores, Inc.* v. *Nashua Manufacturing Co.*, 157 F. (2d) 154. That case is interesting in that it was decided by a divided court. The majority opinion contains the quotation made by petitioner. This opinion also carried the statement that, while the matter as to whether the question of invention is one of fact or of law is not too clear on the authorities, the court would regard it as a question of fact. Judge Woodbury, dissenting, concurred in this holding as to invention being a question of fact but, nevertheless, considered the prior art set up by defendant and ruled that this prior art invalidated the patent. The decision of the majority of the court, also, did not merely hold that there was evidence supporting the District Court's findings, but thoroughly reviewed that evidence. Therefore, although it held the question of invention to be a question of fact, it did not hold, as petitioner would argue, that the facts could not be reviewed by the Court of Appeals. The Court of Appeals did not

merely state that the findings of the trial court were "supportable in view of the evidence."

The petitioner's brief then goes on to discuss further the present interpretation to be given to Rule 52 (a) of the Federal Rules of Civil Procedure. It cites some thirteen cases in which petitions for writs of certiorari on this point were passed upon by this court during the past term. It is important to note that in every instance the court denied the petitions. It is respectfully submitted that the same action should be taken in the present case. In this case, the Court of Appeals did not find as to facts any differently from the trial court. They went over the facts, however, and determined that, as a matter of law, these facts proved definitely that the subject matter of the patent did not involve invention.

Another decision of this court which bears on the question as to whether or not infringement or validity are questions of fact or of law is that in *Market St. Ry. Co.* v. *Rowley,* 155 U. S. 621, 625. Here this court, in considering whether the question of invention was one of law or of fact, made the following statement:

> "The defendant put in evidence a number of patents prior in date to the plaintiff's, and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to say what the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury."

In the present case, the facts are undisputed and the question of validity has equally resolved itself into one of law, in this case depending upon a comparison between the claims and structure disclosed on the face of the patent and the prior art patents before the court.

III.

The third and last point raised by petitioner is an allegation that the Circuit Court of Appeals drew improper conclusions from the Wittenberg file wrapper and that its holdings are in conflict with other Circuit Courts of Appeals. It is urged that this point is entirely without merit, as it is based upon an erroneous reading of the opinion of the Circuit Court of Appeals. The court went over the proceedings in the Patent Office, as shown by the file wrapper, which was of record in the case. It did not state that there was any "file wrapper estoppel." Its decision was based on no such holding.

What the court did do was to have the benefit of the interpretation of the references made by the Examiner. It then studied the references and in part agreed with the Examiner and in part disagreed with him. All that it said about the file history, by way of conclusion, was (R. 372):

> "In any event, the manner in which allowance of these claims was procured seriously impairs the presumption of validity which ordinarily attaches to the grant. Of course, the circumstances are not conclusive against validity but we think they are persuasive."

This is very far from holding that the proceedings in the Patent Office constituted an estoppel. The decision then goes on to state (R. 372):

> "It could be that the Examiner was wrong when he

disallowed the claims and right when he allowed them. However, our study of the prior art in connection with the comments of the Examiner thereon leads us to the conclusion that his action in disallowing the claims was proper."

This referred to the rejection of the claims by the Examiner on references, which rejection was made in the next to the last Office action. The decision then goes on to state (R. 372):

"And we are very definitely of the view that the patentability of these combination claims was not aided by the amendments responsible for their allowance."

Thus, the Circuit Court of Appeals agreed with the earlier position of the Examiner that the claims were invalid over the art cited. The examiner finally reversed himself after the filing of an amendment, adding certain limitations, and allowed the claims. The Circuit Court of Appeals, after considering the claims and the references, held that the Examiner was wrong in reversing himself and allowing the claims. The decision of the Circuit Court of Appeals, therefore, is based upon a thorough consideration of the prior art and not, in any sense, upon a "file wrapper estoppel."

The decision next states (R. 372):

"The patentee perfected a stream-lined apparatus which, as already shown, possessed numerous advantages over that which was old."

Thus, the Circuit Court of Appeals recognized and agreed with the findings of fact of the District Court as to the advantages of the patented structure. The Circuit Court of Appeals, however, did not agree with the conclusion of law drawn from those facts by the trial court. The Circuit Court of Appeals next stated (R. 372):

"We think, however, that such advantages must be

attributed to the skill of the art and not to invention. We hold, therefore, that claims 1, 2 and 6 are invalid for lack of invention."

The above quotations from the opinion of the Circuit Court of Appeals make it very clear that that opinion is based solely upon the careful consideration by that court of the prior art and a holding that, in spite of the advantages of the structure developed by the patentee, it did not amount to invention but merely to the skill to be expected of one in that art.

In view of the statements quoted above from the decision of the Circuit Court of Appeals, it appears clear that the question as to whether or not "file wrapper estoppel" has any bearing on the issue of validity is merely a moot question in the present case. It is unnecessary, therefore, to discuss in detail the various decisions cited by the petitioner in support of its position that a file wrapper estoppel is not available as a defense on the question of validity.

In passing, however, it may be pertinent to mention that the decision in *International Cellucotton Products Co.* v. *Sterilek Co., Inc.,* 94 F. (2d) 10, cited on page 16 of petitioner's brief, has additional statements which bear on the matter of a Circuit Court of Appeals reviewing the prior art and reversing the District Court as to the question of validity. The Court of Appeals in the Second Circuit in that case took exactly the same position as that taken by the Circuit Court of Appeals in the Seventh Circuit in the instant case. There the District Court held six patent claims valid and infringed and, in addition, held one claim not infringed without passing on the validity of the claim. The Circuit Court of Appeals carefully reviewed the prior art considered by the trial court and reversed that court, holding invalid the five claims which

the trial court held valid and infringed. They affirmed the District Court in holding one claim not infringed. In the present case, the Circuit Court of Appeals for the Seventh Circuit reversed the District Court which held claims 1 and 2 valid and infringed and, in this case also, reversed the District Court, which held claim 6 valid but not infringed. The Circuit Court of Appeals held claim 6 to be invalid, passing on the question of validity because of the fact that in this case there was a counterclaim for declaratory judgment.

CONCLUSION.

It is respectfully submitted that the petition for a writ of certiorari should be denied for the following reasons:

1. The case does not come within any of the classes of cases which this court holds subject to review.

2. The Circuit Court of Appeals did not apply a new requirement or hold in conflict with prior decisions of this court in holding the patented structure achieved no patentable new result.

3. The Circuit Court of Appeals did not depart from Rule 52 (a) of the Federal Rules of Civil Procedure in reviewing the prior art in a patent case where no question of the credibility of a witness was involved.

4. The Circuit Court of Appeals did not raise or consider any question of file wrapper estoppel as to validity of the patent, nor consider a rejected claim as itself prior art.

5. The Circuit Court of Appeals did carefully consider the prior art of record and determine and decide that the claims were unpatentable thereover, any advantages of the patented structure being attributable to the "skill of the art and not to invention." In view of this holding of the Circuit Court of Appeals, each of the points raised in the petition, is merely a moot question in the present case.

Respectfully submitted,

CHARLES L. BYRON,
HOWARD W. HODGKINS,
GERRIT P. GROEN,
First National Bank Building,
Chicago 3, Illinois,
Counsel for Respondents.